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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/722,720 | 11/26/2003 | Joseph T. Friel | CISCO15470 | 7341 |
| 5642 7590 07/11/2007 SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044 | | | EXAMINER DANG, HUNG Q | |
| | | | ART UNIT 2621 | PAPER NUMBER |
| | | | NOTIFICATION DATE 07/11/2007 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

Office Action Summary

Application No.

10/722,720

Applicant(s)

FRIEL ET AL.

Examiner

Hung Q. Dang

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/11/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Nair et al. (US 2005/0074063).

Regarding claim 1, Nair et al. disclose a process for the recording, storage, and playback of video data ([0011]; [0067]), comprising the steps of: receiving broadcast video data ([0020]-[0025]; [0098]; [0069]); encoding, using a first compression format, said video into a first encoded file ([0011]; [0069]); storing said first encoded file on a storage device ([0011]; [0069]); retrieving said first encoded file from the storage device ([0011]; [0069]); re-encoding said first encoded file, using a second compression format, to create a second encoded file, wherein said second encoded file is smaller than said first encoded file ([0011]; [0069]; [0083]); storing said second encoded file on the storage device ([0011]; [0069]); and decoding the second encoded file for playback ([0051]; [0069]).

Regarding claim 2, Nair et al. also disclose said first compression format is MPEG-2 ([0100]; [0081]).

Regarding claim 3, Nair et al. also disclose said second compression format is H.264 ([0100]; [0082]).

Regarding claim 4, Nair et al. also disclose encoding using said first compression format is performed substantially in real-time and encoding using said second compression format is performed in non-real-time ([0069]).

Regarding claim 5, Nair et al. also disclose said re-encoding step uses some of the same processing resources that would have been used by the first encoding step if broadcast video data were being encoded or resources that would have been used by the decoding step when a file was being played back ([0083]; [0084]).

Regarding claim 6, Nair et al. also disclose a plurality of first encoded files are stored on said storage device and said re-encoding step includes the step of re-encoding said plurality of first encoded files into second encoded files in the order in which said first encoded files were recorded ([0082]; [0095]; [0097]).

Regarding claim 7, Nair et al. disclose a process for the recording, storage, and playback of video data ([0011]; [0067]), comprising the steps of: receiving digital video data encoded using a first compression format ([0011]; [0069]); storing said received digital video data in a first encoded file on a storage device ([0011]; [0069]); retrieving said first encoded file from the storage device ([0011]; [0069]); re-encoding said first encoded file, using a second compression format, to create a second encoded file, wherein said second encoded file is smaller than said first encoded file ([0011]; [0069]; [0083]); storing said second encoded file on the storage device ([0011]; [0069]); and decoding the second encoded file for playback ([0051]; [0069]).

Regarding claim 8, Nair et al. also disclose said first compression format is MPEG-2 ([0100]; [0081]).

Regarding claim 9, Nair et al. also disclose said second compression format is H.264 ([0100]; [0082]).

Regarding claim 10, Nair et al. also disclose encoding using said second compression format is performed in non-real-time ([0069]).

Regarding claim 11, Nair et al. also disclose a plurality of first encoded files are stored on said storage device and said re-encoding step includes the step of re-encoding said plurality of first encoded files into second encoded files in the order in which said first encoded files were recorded ([0082]; [0095]; [0097]).

Claim 12 is rejected for the same reason as discussed in claim 1 above.

Claim 13 is rejected for the same reason as discussed in claim 2 above.

Claim 14 is rejected for the same reason as discussed in claim 3 above.

Regarding claim 15, Nair et al. also disclose said storage device is a hard disk ([0048]).

Regarding claim 16, Nair et al. also disclose said first encoder and second encoder share data processing resources ([0083]).

Regarding claim 17, Nair et al. also disclose a scheduler that schedules said second encoder to compress said first encoded file into said second encoded file when no broadcast video data is being received ([0069]; [0125]).

Regarding claim 18, Nair et al. also disclose a plurality of first encoded files are stored on said storage device and said scheduler schedules re-encoding of said

plurality of first encoded files into second encoded files in the order in which said first encoded files were recorded ([0082]; [0095]; [0097]).

Claim 20 is rejected for the same reason as discussed in claim 7 above.

Regarding claim 21, Nair et al. also disclose said encoder comprises an H.264 format codec ([0100]; [0082]; Fig. 3B; Fig. 3C).

Regarding claim 22, Nair et al. also disclose said storage device is a hard disk ([0048]).

Claim 23 is rejected for the same reason as discussed in claim 18 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nair et al. (US 2005/0074063) as applied to claims 1-18 and 20-23 above, and further in view of Moroney (US Patent 6,532,593).

Regarding claim 19, see the teachings of Nair et al. as discussed in claim 12 above. Also, Nair et al. disclose a digital media and said second encoder re-encodes said first encoded file so that content of said first encoded file will fit onto the digital media ([0095]; [0097]).

However, Nair et al. do not disclose the digital media to be of removable type.

Moroney discloses a removable digital medium (column 2, lines 33-38).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the removable digital media disclosed by Moroney into the digital video recorder disclosed by Nair et al. because a removable storage device is easier to replace and more portable.

Claim 24 is rejected for the same reason as discussed in claim 19 above.

Conclusion

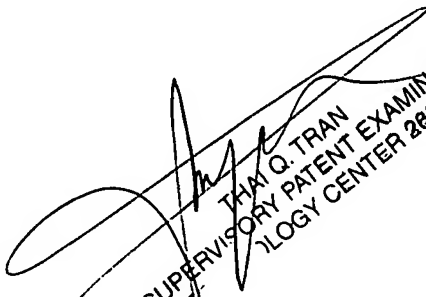
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is 571-270-1116. The examiner can normally be reached on M-Th:7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hung Dang
Patent Examiner



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